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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/720,272	11/25/2003	Jeromo Chaigne	P24410	4775

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EXAMINER	
LAMBELET, LAWRENCE EMILE	
ART UNIT	**PAPER NUMBER**
1732	

DATE MAILED: 08/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/720,272	CHAIGNE, JEROMO	
	Examiner	Art Unit	
	Lawrence Lambelet	1732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *06 June 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-11* is/are pending in the application.

4a) Of the above claim(s) *1-6* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *7-11* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☒ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

Applicant's election of Group II invention in the reply filed on 6/6/2006 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claims 1-6 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Group I invention, there being no allowable generic or linking claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 7, and 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Van De Witte et al (U.S. Patent 6,723,479) in view of Arnold et al (U.S. Patent 6,768,654), and further in view of Guerra (U.S. Patent 5,813,148)

Van De Witte et al, hereafter "Van De Witte", discloses a method of decorating a plastic article in-mold, as recited by claim 7. Van De Witte teaches placing a transfer foil (complex) made up of a decorative layer (transfer layer) applied to a carrier

(decorating layer) having an adhesive layer (fastening layer) into an injection mold for combination with a thermoplastic material which is injected into the mold following placement. This is shown at lines 38-43 and 55-63 in column 1, 4-11 in column 2, and 47-61 in column 7.

Van De Witte teaches that the carrier layer is a polyester film at lines 18-20 in column 3.

Van De Witte does not teach that the decorative layer is constituted with sublimable inks, or that the carrier is transparent or translucent, as required by claim 7. Van De Witte is silent with respect to whether the adhesive layer is applied before or after the application of the decorative layer, as required by claims 10 (after) and 11 (before).

Arnold et al, hereafter "Arnold", teaches that the decorative layer can be deposited as a sublimation ink-transfer at lines 1-6 in column 7, 52-67 in column 3, and 1-8 in column 4. Fig's 1 and 2 illustrate a further teaching of Arnold. A metal layer (decorating layer), at reference character (12), can be disposed on a film (decorating layer), character (14), either above or below with respect to the resin (article), character (16). In the case of the disposition below (Fig. 2), it is apparent that the film must be transparent for the decorating feature to be visible. It is also apparent from Fig. 2 that the adhesive layer of Van De Witte must be applied *after* the decoration step for a bond to be effective. In the case of Fig. 1, the decoration can occur *before* or after. The text for this teaching can be found at lines 25-30 in column 5.

Applicant will appreciate that all of the method steps of claim 7 have been met by the Van De Witte and Arnold references, as discussed above. The preamble definition of the article as a ski boot is not considered to be further limiting. However, should applicant consider this a limitation, the third reference, Guerra, is quoted for the teaching in the Abstract section, and in Fig. 20, wherein decoration is applied to ski boots.

Van De Witte and Arnold are combinable because they are concerned with a similar technical field, namely, in-mold decoration. One of ordinary skill in the art at the time of the invention would have found it obvious to include in the method of Van De Witte the sublimation inks and the layer sequencing, as taught by Arnold, and would have been motivated to do so for protection from abrasion.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Van De Witte in view of Arnold, as applied to claims 7 and 9-11 above, and further in view of Wang et al (U.S. Patent Application Publication 2004/0253428).

Van De Witte and Arnold disclose the method of claims 7 and 9-11, as discussed above.

Van De Witte and Arnold do not teach that the carrier layer is a polyamide, as required by claim 8.

Wang et al, hereafter "Wang", teaches polyamide for a substrate layer (decorating layer) in paragraph [0038] and claim 48 of the reference.

Van De Witte, Arnold and Wang are combinable because they are concerned with a similar technical field, namely, in-mold decoration. One of ordinary skill in the art

at the time of the invention would have found it obvious to include in the method of Van De Witte and Arnold material selection, as taught by Wang, and would have been motivated to do so for versatility of process.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 7 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 10/975439 in view of Arnold. Copending claim 1 teaches three layers for an insert (complex) including a film of first thermoplastic material (decorating layer), a decoration (transfer layer), and an adhesive film (fastening layer). The insert is placed into a mold

whereupon a second thermoplastic material is injected to join with the insert and form the molded article, a component of a sports boot.

Copending claim 1 does not teach subliminal inks for the decoration and does not teach a transparent or translucent material for the thermoplastic film.

Arnold teaches teaches subliminal inks and transparent or translucent film, as discussed above.

Copending application and Arnold are combinable because they are concerned with a similar technical field, namely, in-mold decoration. One of ordinary skill in the art at the time of the invention would have found it obvious to include in the method of copending application the sublimation inks and transparency of layer, as taught by Arnold, and would have been motivated to do so for protection from abrasion.

This is a provisional obviousness-type double patenting rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following documents are cited to further show the state of the art with regard to in-mold decoration of plastic articles requiring protective surfaces:

U.S. Patent 4,490,410 to Takiyama et al

U.S. Patent 6,711,836 to Weiss

U.S. Patent Application Publication 2005/0223602 to Cagliari (not prior art)

U.S. Patent Application Publication 2004/0148807 to Grandin (not prior art)

U.S. Patent Application Publication 2006/0093813 to Wang et al (not prior art)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence Lambelet whose telephone number is 571-272-1713. The examiner can normally be reached on 8 am-4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Johnson can be reached on 571-272-1176. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

CHRISTINA JOHNSON
PRIMARY EXAMINER
8/25/06

LEL
8/25/2006